

## REMARKS

### **I. The Section 102(b) Rejection**

Claim 1 stands rejected under 35 U.S.C. § 102(b), as being “anticipated by any one of the following; Community Plant Variety Rights (CPVR) published application in the European Community, Official CPVO [Community Plant Variety Office] Gazette, the CPVO website, and Ficor Catalogs 1998-2001.” (See page 2 of the Office Action dated May 30, 2003.)

Applicant has admitted that a sale of the instant variety occurred outside the United States as early as March 28, 1998 and that very limited and selective information from a CPVR application for the instant variety was published in the European Community Plant Variety Office (CPVO) Gazette and on the CPVO website. Applicant further admits that limited information for the instant variety was published in Ficor Catalogs for the years 1998-2001. The catalogs were publicly distributed in Ireland and the United Kingdom more than one year prior to the filing date of this U.S. application and the instant variety was offered for sale through those catalogs outside the United States.

Although the text of the CPVO publications and the Ficor catalogs standing alone would admittedly not enable one skilled in the art to make and use the claimed plant variety, the Examiner has relied upon the CPVO publications and the catalogs with their sparse disclosure, limited geographic distribution and restricted sales of the instant variety outside the United States to show that the variety was placed in the public domain more than one year prior to the filing of this application. Thus, pursuant to 35 USC § 102(b), according to the Examiner, “[a]s the plant was publicly available more than one year prior to the U.S. filing and because information regarding the new invention was available in the public domain also more than one year prior to the U.S. filing, no claim is allowed.”

Therefore, the instant variety has been rejected under § 102(b) as allegedly anticipated by the CPVO publications or the Ficor catalogs in combination with purported knowledge in the prior art of the availability of the variety outside the U.S. that would enable one of ordinary skill in the art to reproduce the claimed plant.

**A. For § 102(b), A Reference Must Place The Public In Possession Of The Invention**

Anticipation by a reference occurs when the reference adequately describes the invention in question to a person of ordinary skill in the art to which the invention pertains and the reference qualifies as a printed publication. *See, e.g., In re Paulsen*, 30 F.3d 1475, 1478 (Fed. Cir. 1994) (“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention”). *See also In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) (“We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.*”) (Italics in original.)

The description must enable such a person not only to comprehend the invention but also to make it. *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665 (Fed. Cir. 1986) (“[A] § 102(b) reference ‘must sufficiently describe the claimed invention to have placed the public in possession of it.’ . . . ‘[E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.’ . . . The basis for this rule is found in the description requirement of § 102(b).”)

The standards as to what constitutes a “publication” are well established in the case law. Quoting *Seymour v. Osborne*, 78 U.S. 516, 555 (1870), the CCPA in *LeGrice* set forth the

controlling view:

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do so if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention capable of being put into practical operation. *LeGrice*, 301 F.2d at 936, 133 USPQ at 371.

**B. For § 102, All Elements Of The Invention Must Be Found In A Single Reference**

For anticipation, a reference must disclose all elements of the claimed invention within the four corners of the reference. *Advanced Display Systems Inc. v. Kent State University*, 212 F.3d 1272, 1282 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 904 (2001) (“invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.”) Anticipation cannot be found by combining more than one reference to show the elements of the claimed invention. *In re Saunders*, 444 F.2d 599, 602-03 (CCPA 1971) (“[T]wo references together simply cannot constitute an ‘anticipation’ in the technical sense of that term in patent law.”) “It is hornbook law that anticipation must be found in a single reference, device or process.” *Studiengesellschaft Kohle, m.b.H. v. Dart Indus., Inc.*, 726 F.2d 724, 726-27 (Fed. Cir. 1984). Each case is considered on its own facts. *In re LeGrice*, 301 F.2d 927, (CCPA 1962) (“Each case must be decided on its own particular facts in determining whether, in fact, the description in the printed publication is adequate to put the public in possession of the invention and thus bar patentability

of a plant under the condition stated in Section 102(b)").

Although all elements of the claimed invention must be shown in a single reference, the Federal Circuit has noted that "it is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference." *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). *See also In re Samour*, 571 F.2d 559 (CCPA 1978) (a primary reference disclosing all the elements of a chemical compound anticipates a later claim for that compound even though a method of making the compound is disclosed only in a secondary reference). In *Scripps*, however, the Federal Circuit went on to warn that the use of such extrinsic evidence is narrowly proscribed.

Such factual elaboration is necessarily of limited scope and probative value, for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference: a finding that is not supportable if it is necessary to prove facts beyond those disclosed in the reference in order to meet the claim limitations. The role of extrinsic evidence is to educate the decision-maker to what the reference meant to persons of ordinary skill in the field of the invention, not to fill gaps in the reference. . . . If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not § 102 anticipation but § 103 obviousness. *Scripps*, 927 F.2d at 1576-77 (citations omitted).

Even so, such "[e]xtrinsic evidence may be considered when it is used to explain but not to expand, the meaning of a reference." *In re Baxter Travenol Labs*, 952 F.2d 388, 390 (Fed. Cir. 1991). However, it is not permissible to incorporate specific teachings of a second reference into an allegedly anticipating reference. *See In re Marshall*, 578 F.2d 301, 304 (CCPA 1978) ("[T]o constitute an anticipation, all material elements recited in a claim must be found in one unit of prior art. . . . This basic principal of patent law has not been disturbed by our recent decision, *In re Samour* . . . in which we affirmed a § 102(b) rejection of claims to a chemical compound based on a primary reference which disclosed the compound and additional references which established that a method of preparing the compound would have been obvious to one

skilled in the art. In *Samour*, every material element of the claimed subject matter, the chemical compound, could be found in the primary reference, a disclosure of the compound.”) *See also Al-Site Corp. v. Opti-Ray Inc.*, 28 USPQ2d 1915, 1921 (E.D. N.Y. 1993) (“it is inappropriate for the fact-finder to go beyond the features of a prior art reference in order to find that that reference anticipated the patented invention.”)

### **C. Foreign Public Use And On-Sale Activity Is Not Prior Art Under § 102(b)**

Public availability or on-sale activity of an invention in a foreign country is not a factor in determining patentability under 35 U.S.C. § 102(b). Until an invention is described in a printed publication or patented outside the United States, the foreign use is not deemed to have made the invention available in this country. *See* § 102(b) (barring patentability if an invention was “in public use or on sale in this country, more than one year prior to” an application. It is only the public use or sale of an invention in the United States that can affect the patentability of that invention under 35 U.S.C. § 102(b).

Moreover, using the sale of an invention in a foreign country as extrinsic evidence to augment the otherwise insufficient disclosure of a printed publication is merely an attempt to overcome the limitations of 35 U.S.C. § 102(b). An inadequate reference cannot be used as a vehicle for an improper rejection under § 102(b) based upon a sale of the invention outside the United States. *See, e.g., In re Baxter Travenol Labs*, 952 F.2d at 390 (extrinsic evidence can be used to explain but not expand a reference). A foreign sale or public use of an invention, without more, is not prior art under 35 U.S.C. § 102(b). Renaming it as “common knowledge” in the art and joining it with an otherwise non-enabled reference does not make the combination viable prior art. *See, e.g., Al-Site Corp. v. Opti-Ray Inc.*, 28 USPQ2d at 1921 (inappropriate to go beyond the disclosure to find anticipation by a reference).

**D. Published Citations to the Community Plant Variety Rights Application Are Extremely Limited Information Insufficient to Describe the Invention**

The instant variety, 'Vulcan Time,' is the subject of a pending CPVR application that was filed in the CPVO more than a year prior to the filing date of this U.S. application. Although the Examiner appears to assume that CPVR applications are published, the CPVO has informed Applicant's attorney to the contrary that CPVR applications are not published and not accessible to the general public. Instead, the CPVO publishes only a citation to a new CPVR application in the Official CPVO Gazette at the time the application is filed.<sup>1</sup>

As can be seen from the Official Gazette citation for the instant CPVR application, information regarding new CPVR applications is published in a table format with explanatory headings in numerous different languages, including English. In this particular case, the table of information begins on the page numbered "1/99/13" in the upper right hand corner of the CPVO Gazette page. There are three columns of information listed in the table and an explanation of the entry in each column is shown at the top of the table. (For example, column 1, item a is the "File number"; column 1, item b is the "Date of application," etc.) The information in the table is grouped alphabetically by plant variety, e.g., Aster L., Avena sativa L., etc.

The citation for the CPVR application for the variety that is the subject of this U.S. application is shown in the lower right hand corner of page 1/99/14 of the Gazette. Only six pieces of information regarding the instant plant variety are disclosed in the Gazette citation: the plant variety ("Chrysanthemum"); the file number for the CPVR application ("98/1621"); the filing date of the CPVR application ("21/12/1998" or December 21, 1998); a code number for

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<sup>1</sup> A copy of the Official Gazette citation for the CPVR application was disclosed in Applicant's Supplemental Information Disclosure Statement filed June 17, 2002. A further copy was included with Applicant's Response to the § 1.105 Requirement for Information filed April 1, 2003. The citation from the Gazette was cited as item number 8 on the PTO Form 1449 accompanying the Applicant's Response to the § 1.105 Requirement for Information.

the Applicant ("00301"); a similar code number for the Breeder ("00301"); and a provisional designation for the variety ("*p106/98*"). The cultivar denomination 'Vulcan Time' was not proposed at the time the CPVR application was filed and is not disclosed in the Gazette citation.<sup>2</sup> No further information regarding the variety or the CPVR application is disclosed in the Gazette citation.

Similar sparse information regarding the CPVR application is disclosed on the CPVO web site.<sup>3</sup> The web site listing includes a caveat from the CPVO that the web site is merely a means to improve the dissemination of information on CPVR applications and that the information contained on the web site does not have any official status under the legislation governing the CPVO. The web site is updated periodically and now includes the cultivar denomination 'Vulcan Time,' which was not proposed in the CPVR application until after the filing date of the instant U.S. application. (See Applicant's Response to the § 1.105 Requirement for Information filed April 1, 2003.) The CPVO has informed Applicant's attorney that information is generally posted to the CPVO web site at approximately the same time it is officially published in the CPVO Gazette.

The same sparse information shown in the CPVO Gazette citation is also reflected in the UPOV-ROM GTITM Computer Database citation for the variety that is the subject of this U.S.

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<sup>2</sup> The cultivar denomination 'Vulcan Time' was not proposed in the CPVR application until May 6, 2002 and not officially published by the CPVO until December 15, 2002, which is well after the U.S. application filing date. See Applicant's Response to the § 1.105 Requirement for Information filed April 1, 2003.

<sup>3</sup> A copy of the CPVO web site citation for the instant variety was disclosed in Applicant's Supplemental Information Disclosure Statement filed June 17, 2002. A further updated copy was included with the Applicant's Response to the § 1.105 Requirement for Information filed April 1, 2003 as item number 9 on the PTO Form 1449 accompanying the Response.

application.<sup>4</sup> The cultivar denomination ‘Vulcan Time’ is not shown in the UPOV-ROM Database 2002/01 citation because the denomination was not proposed until May 2002 and not published until December 2002. (See Applicant’s Response to the § 1.105 Requirement for Information filed April 1, 2003.)

**E. The CPVO publications are not effective prior art for anticipation**

With regard to the ‘Vulcan Time’ variety, the CPVO publications simply contain insufficient disclosure to place a person of ordinary skill in the art in possession of the claimed variety. *See In re Paulsen*, 30 F.3d at 1478 (“the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention”). *See also LeGrice*, 301 F.2d at 936, 133 USPQ at 372 (“[B]efore any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.”) (Italics omitted.)

The CPVO publications clearly lack enablement, but even setting aside that issue, the publications are simply too factually deficient to adequately describe the claimed variety in order to place the public in possession of it. The Gazette citation, for example, does not contain the denomination ‘Vulcan Time’ and recites no characteristics beyond the provisional designation “p106/98” that could be used to distinguish the variety from any other Chrysanthemum variety listed in the Official Gazette. Not even the flower color of the variety is disclosed. The six bare pieces of information disclosed in the CPVO Gazette are simply too sparse to constitute an adequate description of the claimed variety and to place it in the possession of one of ordinary

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<sup>4</sup> The UPOV-ROM Computer Database citation was enclosed as item number 10 on the PTO Form 1449 accompanying the Applicant’s Response to the § 1.105 Requirement for Information. The Database has been updated but an updated version is not available to the Applicant.



skill in the art. In other words, it fails to meet the standards of *Seymour v. Osborne* to qualify as a printed publication. The remaining CPVO publications do not cure this deficit. As a consequence, the CPVO publications cannot form the basis of a § 102(b) anticipation rejection – there is simply too much description missing from their disclosure to constitute an adequate description.

**F. The CPVO publications cannot be combined with extrinsic evidence to show anticipation**

In this application, the Examiner has rejected the claim over the combination of a CPVO publication with extrinsic evidence of public availability of the claimed variety through a sale outside the United States. Under closer scrutiny, it is apparent that this combination cannot be maintained. First, as discussed above, the information disclosed in the CPVO publications is simply too deficient to provide an adequate description of the claimed variety sufficient to place the variety in the possession of one of ordinary skill in the art. *Ex Parte Thomson* and *In re LeGrice* are inapposite here and are distinguishable on their facts.

In *LeGrice*, the CCPA held that a description and photograph of a hybrid rose in a publication did not constitute an adequate description of that rose such as would bar a plant patent. The photograph did not and could not enable one with skill in the art to make the rose. In *Ex Parte Thompson*, the Board of Patent Appeals distinguished *LeGrice* and found anticipation by publications describing a Siokra cotton cultivar, even though the publications did not describe the inventor's breeding process. The publications indicated that seeds for the cotton cultivar were widely available outside the U.S.

In both *Thomson* and in *LeGrice*, the printed publication at issue described the claimed plant in sufficient detail to distinguish the variety from others and place the claimed plant in the possession of a person of ordinary skill but for one issue: enablement to make the plant. There

was no dispute regarding the sufficiency of the description of the plant variety except as to enablement. In *Thomson*, there was extrinsic evidence regarding enablement; in *LeGrice* there was not, hence the outcome in each case was different.

It is clearly not the same circumstance in this case. The printed publications relied upon by the Examiner in the instant case, the CPVO publications, are factually insufficient to comprise an adequate description of the claimed plant even if the lack of enablement is ignored. The citation does not in itself contain sufficient disclosure to distinguish the variety from any others. The Examiner is not using the evidence of public availability to show only the state of knowledge in the prior art. It is rather being used improperly to fill a multitude of gaps in the description of the invention and expand that description far beyond what it rightfully discloses absent the combination. It is not permissible to use extrinsic evidence to incorporate missing description of the variety and complete an otherwise inadequate disclosure. Thus, in this instance, the printed publication relied upon by the Examiner is not effective prior art and cannot be expanded by combination with evidence of public availability.

Second, as a factual matter, there is simply insufficient disclosure in the CPVO publications to permit a person of ordinary skill in the art to combine them with the evidence of foreign sales of the claimed variety. The published citation for the CPVR application admits of only the provisional designation “p106/98” and not the cultivar denomination ‘Vulcan Time.’ The evidence of public availability of the claimed variety shows that the variety was sold only under the cultivar denomination ‘Vulcan Time’ and not under the provisional designation “p106/98.” A person of ordinary skill in the art could not have recognized a connection between the CPVR citation for the variety “p106/98” and the commercial variety named ‘Vulcan Time’ which was offered for sale. This disconnect prevents any viable combination between the two.

Hence the evidence of public availability of the variety cannot be used to relieve the inadequate disclosure or lack of enablement of the published citation for the CPVR application because it was factually impossible to make the combination. In this instance, the Section 102(b) rejection cannot stand.

**G. The Ficor Catalogs Are Insufficient To Place The Public In Possession Of The Claimed Variety**

The variety that is the subject of this U.S. plant patent application has been sold and offered for sale under the cultivar denomination 'Vulcan Time' outside the United States for more than one year prior to the U.S. application filing date. (See Applicant's Response to the § 1.105 Requirement for Information filed April 1, 2003.) The variety has been offered for sale in successive Ficor catalogs, which were distributed in Ireland and the United Kingdom, since October 1997, however, the first actual sale of the variety 'Vulcan Time' occurred in the U.K. on March 28, 1998.<sup>5</sup> Applicant is not aware of any sale or public distribution of the 'Vulcan Time' variety under any name or denomination other than 'Vulcan Time.' Nor is applicant aware of any sale, offer for sale or other public disclosure of the variety in the United States more than a year prior to the filing date of this U.S. application.

The Examiner, however, has relied on the Ficor catalogs as printed publications under 35 U.S.C. § 102(b) and as evidence that the variety was publicly available outside the United States more than one year prior to the U.S. filing date.

As printed publications, the Ficor catalogs clearly lack enablement since they do not teach one of ordinary skill in the art how to make the plant variety in question. *See LeGrice*, 301 F.2d at 944, 133 USPQ at 378 (mere description of a plant is not an enabling disclosure). Because the catalogs are not enabling, the information disclosed in the catalogs is inadequate to

place the variety in the possession of one of ordinary skill in the art. As a consequence, the catalogs alone cannot form the basis of a § 102(b) anticipation rejection.

The catalogs also suffer from further defects as printed publications. The description regarding the ‘Vulcan Time’ variety disclosed in the Ficor catalogs is minimal at best and not substantially greater than the information disclosed in the Official CPVO Gazette citation for the corresponding CPVR application. In the 1998 Ficor catalog, for example, ‘Vulcan Time’ first appeared as a new variety in an alphabetical listing at page 3 of the catalog and then at page 13 with fifteen other varieties under the general page heading “Pot Varieties.” The Pot Varieties are divided into three tables and ‘Vulcan Time’ is listed with seven other varieties in a small table entitled “Bronze Red Single.”

The table entitled Bronze Red Single is largely devoid of any substantive description of the ‘Vulcan Time’ variety that would clearly distinguish it from the other “Bronze Red Single” varieties listed in the table. Aside from the name of the variety, the table gives only six discrete pieces of information regarding each variety listed, three of which relate to royalty rate and plant availability from the distributor. A column entitled “Notes” contains a subjective and cryptic evaluation of the variety as “[m]ost floriferous red single which holds its colour. Excellent habit, very good shelf life.” For other varieties listed in the table, the Notes column contains similar comments, for example, “[v]ery dark red single with good compact habit,” and “[b]lood red single, holds colour well in high light, good foliage and habit.” There are no pictures of the variety in the catalog and no other disclosure directed at distinguishing characteristics, or comparisons and contrasts of ‘Vulcan Time’ with other varieties. The entries in the Ficor catalogs for the other years 1999-2001 are substantially identical.

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<sup>5</sup> Copies of the Ficor catalogs were enclosed with the PTO Form 1449 accompanying Applicant’s Response to the § 1.105 Requirement for Information filed April 1, 2003.

The Ficor catalog descriptions alone are simply insufficient to place a person of ordinary skill in the art in possession of the claimed variety even without reaching the question of enablement to make the variety. The disclosure of the Ficor catalogs is clearly too factually deficient to adequately describe the claimed variety with any specificity. Although the catalogs list the denomination ‘Vulcan Time,’ they otherwise give few characteristics beyond the name that could be used to distinguish the instant variety from any other “Bronze Red Single” Chrysanthemum listed in the catalogs. The six or seven bare pieces of information contained in the catalog are simply too sparse to constitute an adequate description of the variety.

As a consequence, the catalogs alone cannot form the basis of a § 102(b) anticipation rejection as a printed publication. Their description is too insufficient to be effective prior art as a printed publication, before even reaching enablement. Like the CPVO publications discussed above, the Ficor catalogs fail to meet the standards of *Seymour v. Osborne* to qualify as a printed publication and cannot support a § 102(b) anticipation rejection.

#### **H. The Combination Of The Ficor Catalog With Foreign Availability Is An Improper Attempt To Overcome The Limitations Of § 102(b)**

Although the text of the Ficor catalogs standing alone would not enable one skilled in the art to make and use the claimed plant variety, the Examiner has relied on the references as printed publications under 35 USC § 102(b). When a claim is drawn to a plant, a prior art reference, combined with knowledge in the particular art, must enable one of ordinary skill to reproduce the plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962).

The Examiner is apparently relying on *Ex Parte Thomson* for the position that if one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) (“[T]he applied [§ 102(b)] rejection does not rely upon

or incorporate the public use or on sale bar of the statute. . . . [T]he material disclosed in each [publication], when considered in conjunction with the knowledge of the skilled cotton grower, would have enabled such a skilled artisan to make the claimed Siokra cultivar, along with its seeds, plants, pollen, etc., by purchase and planting of the requisite seeds.”)

As discussed above, the Examiner’s position must be thus that the Ficor catalogs would be enabled as printed publications by evidence that the claimed variety was publicly available somewhere. Since the instant plant variety was available to the public in at least Ireland and the U.K. more than one year prior to the U.S. filing date, according to the Examiner’s position, this would constitute knowledge in the prior art sufficient for enablement of the Ficor catalog. It is apparent, however, that this combination cannot be maintained.

The controlling case authority here is *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). *LeGrice* is a decision from the CCPA, predecessor to the U.S. Court of Appeals for the Federal Circuit, which has recognized CCPA opinions as binding precedent. *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982). Even where it is possible that a prior decision of the CCPA would be decided differently today, it still stands as binding precedent until overruled. *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985). See also *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991). Moreover, since the CCPA always sat en banc, its decisions may not be overturned by a later Federal Circuit panel, but only by the Federal Circuit setting en banc. *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

As discussed above, in *LeGrice*, two plant patent applications for hybrid rose varieties were rejected under § 102(b) on grounds that the varieties had been described in printed publications outside the United States more than a year before their U.S. filing dates. The

publications occurred in the National Rose Society Annual of England and in catalogues that included photographs of the hybrid roses. On appeal from the Examiner's final rejections, the Board of Appeals affirmed, and the cases were consolidated for appeal to the CCPA. *Id.*, 301 F.2d at 930, 133 USPQ at 367.

The CCPA reversed the Board of Appeals, holding that the published descriptions of the claimed rose lacked enablement and did not constitute an adequate description of the roses as would bar a plant patent. Focussing on the printed publications, the CCPA reasoned as follows:

In holding that the publications here in issue constitute a legal bar to a granting of patents on the *rosa floribunda* plants described in the applications here on appeal, we think the examiner and the Board of Appeals disregarded what we have found to be the legally imposed limitations on the meaning of the clause "described in a printed publication" in section 102(b) in the prior cases in which the courts have interpreted the clause in determining whether a particular description in a publication will constitute a statutory bar to the grant of a patent. . . [T]his clause requires that the description of the invention in the printed publication must be an "enabling" description. Our study of the prior cases which have imposed this interpretation on the clause indicates that the proper test of a description in a publication as a bar to a patent as the clause is used in section 102(b) requires a determination of whether one skilled in the art to which the invention pertains could take the description of the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought. Unless this condition prevails, the description in the printed publication is inadequate as a statutory bar to patentability under section 102(b). *LeGrice*, 301 F.2d at 938-39, 133 USPQ at 373-74.

With regard to the printed publications and catalogs relied upon for the rejection in *LeGrice*, the CCPA disagreed with the view that its holding meant that plant publications must be "totally ignored," and focused instead on the "description in the printed publication."

Instead, it requires that the facts of each case be carefully considered to determine whether the description in the printed publication in question *does in fact* place the invention in the possession of the public. Each case must be decided on its own particular facts in determining whether, in fact, the description in the printed publication is adequate to put the public in possession of the invention and thus bar patentability of a plant under the conditions stated in Section 102(b). While the present knowledge of plant genetics may mean as a practical matter, that the descriptions in such general publications as here are

involved cannot be relied upon as a statutory bar under section 102(b), we must be mindful of the scientific efforts which are daily adding to the store of knowledge in the fields of plant heredity and plant eugenics which one skilled in this art will be presumed to possess. *LeGrice*, 301 F.2d at 939, 133 USPQ at 374 (footnote omitted, italics in original).

In the instant case, the circumstances are substantially similar to that in *LeGrice*. The Examiner has rejected claim 1 over the Ficor catalogs as printed publications in combination with evidence of availability outside the U.S. What makes the Examiner's position particularly untenable here is that similar circumstances to those relied upon by the Examiner in the instant application were present forty years ago in *LeGrice* and the CCPA reasoned differently. Indeed, the printed publications relied upon in *LeGrice* also included catalogs advertising the claimed plant varieties. The Court even commented on the catalog descriptions in its opinion. See *LeGrice*, 301 F.2d at 932, 133 USPQ at 368. Thus, although the Court in *LeGrice* was clearly aware of the catalog listings of the hybrid rose varieties outside the U.S., it failed to take notice of those listings as possible evidence of foreign public availability.

Had the Court considered the catalog listings of the hybrid rose varieties in *LeGrice* to be determinative of enablement, as asserted here by the Examiner, it would have at least acknowledged the possibility of foreign availability as an enabling disclosure within the "common knowledge" in the prior art. In fact, the Court made no ruling that foreign availability was in evidence or would have been enabling, but instead held that "[t]he descriptions of the new roses in the instant publications, are incapable of placing these roses in the public domain by their descriptions *when interpreted in the light of the knowledge now possessed by plant breeders*. The roses disclosed in the appealed applications are not, therefore, 'described in a printed publication' within the meaning of 35 U.S.C. 102(b)." *LeGrice*, 301 F.2d at 944, 133 USPQ at 378 (footnote omitted, italics added).

Thus, although the catalog listings of the claimed roses were within the "common



knowledge” *then possessed* by plant breeders, the CCPA failed to comment on or even acknowledge that information regarding foreign availability could have been enabling. The CCPA noted instead in footnote 7 that the knowledge of plant breeders was constantly increasing “so that they may *someday* secure possession of a plant invention by a description in a printed publication as is now possible in other fields of inventive effort.” *Id.*, 301 F.2d at 939 n. 7, 133 USPQ at 374 n. 7 (emphasis added).

The CCPA did not have to wait for “someday” to arrive for enablement of published plant descriptions if a disclosure of foreign availability by a catalog would have sufficed. Clearly, a simple disclosure of foreign availability for a plant variety is not part of the constantly increasing “knowledge of plant breeders” contemplated by the CCPA in *LeGrice*. No “contemporaneous advancement in plant heredity and eugenics” as discussed by the CCPA in *LeGrice* is required for reporting the catalog availability of a plant variety. Indeed, having had the clear opportunity to rule on the same genre of facts as present in the instant case, the CCPA ignored the possible foreign availability of the claimed varieties as evidence of enablement within the common knowledge in the prior art.

Later case authority cannot overrule *LeGrice* nor does it attempt to do so. As noted by the CCPA in *LeGrice*, each case is considered on its own merits. *LeGrice*, 301 F.2d at 939, 133 USPQ at 374. In *Ex Parte Thomson*, for example, the Board of Patent Appeals distinguished *LeGrice* on the facts in that case and found anticipation of a *utility* patent by publications describing a Siokra cotton cultivar, even though the publications did not describe the inventor’s breeding process. The publications, however, indicated that seeds for the cotton cultivar were widely available outside the U.S. and the Board concluded that the publications were thereby enabled. *Ex Parte Thomson*, 24 USPQ2d at 1620-21 and n. 1.

Moreover, the printed publication at issue in *Thomson* described the claimed plant in sufficient detail to distinguish the variety from all others and place the claimed plant in the possession of a person of ordinary skill but for one issue: enablement to make the plant. There was no dispute regarding the sufficiency of the description of the plant variety otherwise except as to enablement.

That is clearly not the same circumstance in this case. The Ficor catalogs, as well as the CPVO publications discussed above, are too factually sparse to comprise an adequate description of the claimed plant even if the lack of enablement is ignored. The publication does not in itself contain sufficient disclosure to distinguish the instant variety from other varieties included there, let alone varieties not part of the catalog. The published description is too meager to place the claimed variety in the possession of one of ordinary skill in the art. In addition, the Ficor catalog lacks enablement.

The evidence of foreign availability of the claimed variety cannot be used to relieve the fatal defects of the printed publications. The Examiner is not using the evidence of foreign availability just to show the state of knowledge in the prior art or explain the catalog disclosures. It is rather being used to fill a multitude of gaps in the description of the invention and expand the printed publication far beyond what it rightfully discloses absent the combination.

The Examiner has not made any distinction between the facts of *LeGrice* and those of the current case nor asserted any rationale for why the *LeGrice* decision should result in a different outcome based on the similar factual circumstances. Per the reasoning of the *LeGrice* decision, evidence of the foreign availability of a claimed variety is not useful to relieve the inadequate enablement of a printed publication. Despite an ample opportunity to do so, the CCPA in *LeGrice* did not equate foreign availability with enablement of a printed publication, which

position is advanced by the Examiner in the instant application. Thus, the Examiner is foreclosed by a contrary result in *LeGrice* on similar facts as in the instant case from using the evidence of foreign availability to prove enablement. That route is incompatible with *LeGrice*.

The Examiner has made a flawed combination for anticipation. Relying on the rationale of *LeGrice*, the public availability of the claimed variety outside the U.S. will not supply the missing enablement of the plant description in the Ficor catalog (or the CPVO publications) under the guise of a Section 102(b) rejection. Moreover, it is not permissible to use extrinsic evidence to add to a disclosure that is insufficient for anticipation and thereby complete an otherwise inadequate description. Such augmentation is contrary to the Section 102(b) statute and contrary to the case law on Section 102(b) discussed above.

Under the circumstances, the Section 102(b) rejection here cannot stand. Plant descriptions, "just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled. *LeGrice*, 301 F.2d at 944, 133 USPQ at 378. In the instant case, the Ficor catalogs lacks at least enablement to do so, and per *LeGrice*, the Examiner has failed establish otherwise.

### **III. Conclusion**

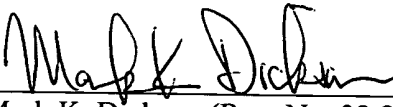
It is respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome and should be withdrawn. There are no further rejections or objections to the disclosure or the claim and the application is now believed to be in condition for allowance.

No additional fees are believed to be due, however, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 08-3038 referencing docket number 10451.0016.NPUS00.

The Examiner is invited to contact the undersigned attorney at (650) 463-8100 or at [DicksonM@howrey.com](mailto:DicksonM@howrey.com) regarding any further questions, comments or suggestions relating to this patent application.

Respectfully submitted,

Date: November 26, 2003

  
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